

DOCKET NO: 209833US0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
ROBERT KUHLMANN, ET AL. : EXAMINER: JOHNSON, E. M.
SERIAL NO: 09/991,640 :
FILED: NOVEMBER 26, 2001 : GROUP ART UNIT: 1754
FOR: HIGH-STRUCTURE :
PRECIPITATED SILICAS :

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is an appeal of the Final Rejection dated January 27, 2004 of Claim 18. A
Notice of Appeal is **submitted herewith**.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Degussa AG having an address at
Bennigsenplatz 1, D-40474 Dusseldorf, Germany.

II. RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative and the assignee are aware of no appeals
or interferences which will directly affect or be directly affected by or have a bearing on the
Board's decision in this appeal.

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III. STATUS OF THE CLAIMS

Claim 18 stands rejected and is herein appealed. Claims 1-17 otherwise remain in the application. Of these claims, Claims 1-4 and 10-17 stand rejected. **While no appeal is taken therefrom, Appellants do not admit that the claimed subject matter therein is unpatentable.** Claims 5-9 are directed to allowable subject matter.

IV. STATUS OF THE AMENDMENTS

An amendment under 37 CFR 1.116 was timely filed on February 27, 2004. In an Advisory Action entered April 8, 2004, the Examiner indicated that upon the filing of an appeal, the amendment will not be entered.

V. SUMMARY OF THE INVENTION

The present invention of Claim 18 is as follows:

A precipitated silica having the following physico-chemical characteristics:

pH (5% in water) (ISO 787-9)		3 - 8
BET surface area (DIN 66131)	(m ² /g)	400 - 600
DBP absorption value (DIN 53601, in relation to dried substance)	(g/100 g)	>380 - 420
Tapped density (ISO 787-11)	(g/l)	100 - 200
ALPINE sieve residue > 63μ (ISO 8130-1)	(%)	0.1 - 40

See the table at the bottom of page 2 of the specification or original Claim 1, and the specification at page 3, line 3.

VI. ISSUES

Whether Claim 18 is anticipated under 35 U.S.C. § 102(b) by U.S. 4,495,167 (Nauroth et al)?

VII. GROUPING OF THE CLAIMS

Only Claim 18 is appealed.

VIII. ARGUMENT

Claim 18 stands rejected under 35 U.S.C. § 102(b) as anticipated by Nauroth et al. That rejection is untenable and should not be sustained.

As confirmed by Reference Example 1 herein, described in the specification at pages 6-7, the DBP absorption value reported in Nauroth et al for their Example 1 is incorrect. As confirmed in Reference Example 1, the DBP absorption value of Nauroth et al's Example 1 is only 355 g/100 g. Indeed, Appellants respectfully submit that a DBP absorption value of at least 380 g/100 g cannot be obtained by the process disclosed in Nauroth et al.

The table below tabulates the times of the steps in Nauroth et al's Example 1 and an example according to the present invention:

	Invention	Nauroth
adding waterglass and sulfuric acid together	13 min	13 min
interrupting the precipitation	90 min	90 min
adding waterglass and sulfuric acid together	34 min	43 min
total precipitation time	137 min	146 min
final silica concentration	38 – 42 g/l	46 g/l

As the table shows, the second precipitation step for the present invention was shortened about 21% from Nauroth et al, resulting in a shorter overall precipitation time and about 9-18% overall lower silica concentration. These modifications assure DBP absorption value of at least 380 g/100 g, which is neither disclosed nor suggested by Nauroth et al.

In the Final Rejection, in response to the above arguments, the Examiner finds that Appellants appear to admit that the claimed product features are disclosed in Nauroth et al, and that it is unclear which of Appellants' representations to the Office is correct -- that made in Nauroth et al or that made herein, noting that they are both commonly assigned. The Examiner also appears to be concerned that Nauroth et al, which has already expired, was based on incorrect disclosure.

In reply, Appellants' assignee represents that it is not able to explain why the data shown in Table 2 of Nauroth et al, particularly Example 1, indicates a DBP number of 380 g/100g but now further represents that it is very unlikely that a silica exhibiting a DBP number greater than 380 g/100g can be produced by the process disclosed in Nauroth et al, although the assignee cannot guarantee that it is impossible. Nevertheless, this issue should now be moot, because the claim on appeal requires that the DBP be greater than 380 g/100g, while Nauroth et al does not disclose a higher DBP.

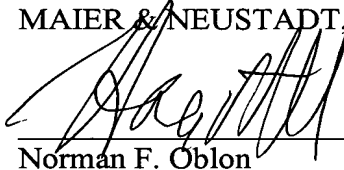
For all the above reasons, it is respectfully requested that the rejection over Nauroth et al be REVERSED.

IX. CONCLUSION

For the above reasons, it is respectfully requested that all the rejections still pending in the Final Office Action be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in dark ink, appearing to read 'Norman F. Oblon', is written over a horizontal line.

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APPENDIX

CLAIMS ON APPEAL

Claim 18: The precipitated silica according to Claim 1, wherein the DBP absorption value is greater than 380 g/100 g.

For the benefit of the Board, Claim 1 is reproduced below:

Claim 1: A precipitated silica having the following physico-chemical characteristics:

pH (5% in water) (ISO 787-9)		3 – 8
BET surface area (DIN 66131)	(m ² /g)	400 – 600
DBP absorption value (DIN 53601, in relation to dried substance)	(g/100 g)	380 – 420
Tapped density (ISO 787-11)	(g/l)	100 – 200
ALPINE sieve residue > 63μ (ISO 8130-1)	(%)	0.1 - 40